



RECEIVED  
JAN 08 2003  
TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 1635
	)	
RICCARDI, Carlo	)	Examiner: J. Epps
	)	
Appln. No.: 09/403,861	)	Washington, D.C.
	)	
Filed: February 11, 2000	)	January 7, 2003
	)	
For: INTRACELLULAR MODULATORS	)	Atty. Docket: RICCARDI=1
OF APOPTOPIC CELL DEATH	)	
PATHWAYS	)	
	)	
Confirmation No. 7791	)	

# 36/K.T.  
1/10  
REPLY

REPLY

Honorable Commissioner for Patents  
Washington, D.C. 20231

Sir:

This reply is responsive to the Communication dated December 17, 2002, Paper No. 25.

The examiner states that the reply filed on September 24, 2002, is not fully responsive to the prior Office Action because applicants have not provided corrected drawings as required in Paper No. 16, mailed August 8, 2001, and in Paper No. 20, mailed May 12, 2002. In Paper No. 20, the examiner stated that, in order to avoid abandonment of this application, the drawings must be corrected as required and referred to 37 CFR 1.84 in Paper No. 16. This requirement is respectfully traversed.

The amendment to 37 C.F.R. §1.85(a), which became effective on November 29, 2000, states that objections to the drawings will not be held in abeyance. However, this amendment to 37 C.F.R. §1.85(a) was made as part of the rule-making of changes to implement 18-month publications of patent applications, the final rule of which was

published in the Federal Register of September 20, 2000. In the applicability date section of this rule-making, appearing at 65 Fed. Reg. 57024, it is explicitly stated that the changes to 37 C.F.R. §1.85 "apply to any patent application filed on or after November 29, 2000, and to any patent application in which applicant requests voluntary publication".

As the present application was filed prior to November 29, 2000, and no request for voluntary publication has been made in the present application, the rule to which the examiner refers is not applicable to this case. Furthermore, even though a RCE was filed on September 20, 2002, in this application, the original filing date is retained. A RCE does not have the effect of a CPA as being a new patent application filed on or after November 29, 2000. Accordingly, the previous procedure of allowing one to request that drawing corrections be held in abeyance until allowable subject matter is indicated, in accordance with 37 C.F.R. §1.111(b), is still applicable to this case (see MPEP §608.02(b) as it appeared in the 7<sup>th</sup> Edition of the Manual of Examining Procedure).

As the procedure of filing formal drawings after an indication of allowability is still applicable to this case (i.e., the new 37 C.F.R. §1.85(a) is not applicable thereto), it is respectfully requested, pursuant to 37 C.F.R. §1.111(b), that the corrections to the drawings be held in abeyance until allowable subject matter is indicated in the case. The corrections requested are merely matters of form that do not need to be corrected to permit further examination of the case.

The examiner also states that applicants have not provided adequate support in the specification as filed for the amendments of the instant claims in Paper No. 21 and that applicant's amendment does not comply with MPEP 714.02, 2163.06, and 2163.04.

The claims have been amended to recite a GILR protein chemically modified by being conjugated or complexed with molecules facilitating or enhancing the transport of said GILR protein across the cell membrane. In the preliminary response filed September 24, 2002, the examiner's attention was respectfully directed to page 33, lines 1-18 of the present specification where chemical modification of the amino acid residues by conjugation is disclosed and to page 42, lines 1-14 of the specification where chemical modification by being complexed to a ligand such as biotin or folate is disclosed.

MPEP 2163.07 states that mere rephrasing of a passage does not constitute new matter and, accordingly, a rewording of a passage where the same meaning remains intact is permissible. Thus, page 33, lines 1-2 disclose that derivatives may be prepared by standard modifications of the side groups of one or more amino acid residues and lines 7-9 disclose that derivatives may have chemical moieties such as carbohydrate or phosphate residues. Page 41, lines 12-14, discloses that peptides can be chemically modified or derivatized to enhance their permeability across the cell membrane and facilitate the transport of such peptides through the membrane and into the cytoplasm. Page 41, lines 22-24, discloses being "conjugated or complexed" with molecules that facilitate entry into the cell and Page 42, lines 10-11, discloses a complex formed between a compound to be delivered into the cytoplasm (i.e., GILR protein) and a ligand, such as biotin or folate.

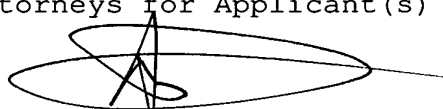
In re Appln. No. 09/403,861  
Confirmation No.: 7791

Accordingly, the recitation in the claims of "chemically modified by being conjugated or complexed with molecules facilitating or enhancing the transport of said GILR protein across the cell membrane" is fully supported by the specification as originally filed.

Respectfully submitted,

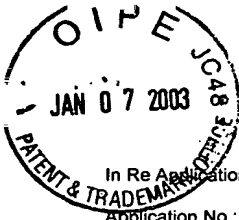
BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant(s)

By

A handwritten signature in black ink, appearing to be "Allen C. Yun", is written over a horizontal line. The signature is stylized with a large, sweeping loop.

ALLEN C. YUN  
Registration No. 37,971

ACY:pp  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528  
G:\BN\S\Ser1\riccardi\pto\reply.doc



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: RICCARDI, Carlo

Application No.: 09/403,861

Filed: February 11, 2000

For: INTRACELLULAR MODULATORS OF APOPTOPIC CELL DEATH PATHWAYS

Art Unit: 1635

Examiner: J. Epps

Washington, D.C.

Atty.'s Docket: RICCARDI=1

Date: January 7, 2003

1635  
RECEIVED

JAN 08 2003

TECH CENTER 1600/2900

THE COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Sir:

Transmitted herewith is a [XX] REPLY [ ] \_\_\_\_\_

in the above-identified application.

[ ] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

[XX] No additional fee is required.

[ ] The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)		(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR		PRESENT EXTRA EQUALS
TOTAL	* 8	MINUS	** 20		0
INDEP.	* 1	MINUS	*** 3		0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 42	\$
+ 140	\$
ADDITIONAL FEE TOTAL	
\$	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 84	\$
+ 280	\$
TOTAL	
\$	

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[ ] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

## Small Entity

## Response Filed Within

[ ] First - \$ 55.00  
[ ] Second - \$ 200.00  
[ ] Third - \$ 460.00  
[ ] Fourth - \$ 720.00

## Month After Time Period Set

## Other Than Small Entity

## Response Filed Within

[ ] First - \$ 110.00  
[ ] Second - \$ 400.00  
[ ] Third - \$ 920.00  
[ ] Fourth - \$ 1440.00

## Month After Time Period Set

[ ] Less fees (\$ ) already paid for \_\_\_\_ month(s) extension of time on \_\_\_\_\_.

[ ] Please charge my Deposit Account No. 02-4035 in the amount of \$\_\_\_\_\_.

[ ] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$\_\_\_\_\_.

[ ] A check in the amount of \$\_\_\_\_\_ is attached (check no. ).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

Attorneys for Applicant(s)

By:   
Allen C. Yun  
Registration No. 37,971

Facsimile: (202) 737-3528  
Telephone: (202) 628-5197